

USSN: 09/515,978

Docket No.: 55250US002

that the cube corner elements present on the compound substrate include both cube corner cavities and cube corner peaks.

Applicant submits that the Amendment places the application in better form for appeal. The Amendment was not earlier presented because it was believed that previously presented arguments and amendments were sufficient to overcome the grounds of rejection.

#### § 112 Rejections

Claims 1-8 and 15 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards (or Applicants regard) as the invention. Applicant submits that that this rejection has been rendered moot by the cancellation of claims 1-8. Claim 15 was withdrawn from consideration in a previous Response.

#### § 102/103 Rejections

Claims 1-4 and 6-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Mihalek (US Patent 5,429,857). It is believed that the cancellation of claims 1-8 has rendered this rejection moot.

The rejection of claim 15 under 35 U.S.C. § 102(b)/103 (a) by Mihalek (US Patent 3,741,623), Oshima (US Patent 5,866,233), Bacon (US Patent 5,614,286) or Nilsen (US Patent 5,657,162) is moot as claim 15 has been withdrawn in a previous response.

The rejection of claim 5 under 35 U.S.C. § 103 (a) by Mihalek (US Patent 3,741,623) is moot, as claim 5 has been cancelled.

#### Potential Allowable Subject Matter

The Examiner has indicated that potentially allowable subject matter is present and has referred to pages 13 and 14 of the specification. In a telephonic interview with the Examiner, on 03/03/2003, the undersigned discussed potentially adding language to claims 16, 20 and 40 that would recite the presence of cube corner cavities. Upon review of this language with his client, it became clear that this language would limit the invention of these claims unnecessarily. The structures surface that is the subject of those claims may be either a cube corner cavity or a cube corner peak. This is especially clear in the Figs (e.g., Figs. 9-11, 14 and 22). Accordingly, Applicant has amended claims 16, 20 and 40 to recite the presence of the cube corner elements on the structured surface. This wording captures both the presence of

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cube corner cavities and cube corner peaks. Applicant believes that the proposed language is within the spirit of the amendments discussed with the Examiner and reflects the nature of the invention embodied by claims 16, 20 and 40.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested. Allowance of claims 16-23 and 40, as amended, at an early date is solicited.

Respectfully submitted,

By James V. Lilly  
James V. Lilly

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| Registration Number<br>27,817 | Telephone Number<br>651-733-1543 |
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Office of Intellectual Property Counsel  
3M Innovative Properties Company  
P.O. Box 33427  
St. Paul, Minnesota 55133-3427  
Facsimile: (651) 736-3833

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Version With Markings to Show Changes Made

16. (Amended) A compound substrate comprising a substantially replicated substrate having a structured surface and a discontinuous machined substrate covering only a portion of the structured surface, the compound substrate also comprising at least one geometric structure [having] comprising a cube corner element that has at least one face disposed on the structured surface and at least another face disposed on the machined substrate.

20. (Amended) A compound substrate comprising a substantially replicated substrate and a machined substrate, the replicated substrate having a structured surface and the machined substrate disposed in discrete pieces on the structured surface each of the replicated and machined substrates having an exposed surface that defines a cube corner element on the compound substrate.

40. (Amended) A compound substrate having a structured surface comprising a substantially replicated portion and a machined portion, the compound substrate further comprising at least one compound face thereon wherein the at least one compound face has a substantially planar surface having a first face portion on the machined portion of the compound substrate and a second face portion on the substantially replicated portion of the substrate, the first and second face portions being on opposite side of the transition line, the first and second face portions comprising separate faces of a cube corner element.